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IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. 446

CREST SPECIALTY (NOT INC.) A LIMITED PARTNERSHIP CONSISTING OF BEN B. MANASTER, ROSE MANASTER, CAROL RUTH MANASTER, AND SOL ELIOT,

Petitioner,

vs.

DAVID C. TRAGER, DOING BUSINESS AS TOPIC TOYS, AND EOINA NUDELMAN, AN INDIVIDUAL,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT.

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CREST SPECIALTY (NOT INC.) A LIMITED PARTNERSHIP CONSISTING OF BEN B. MANASTER, ROSE MANASTER, CAROL RUTH MANASTER, AND SOL ELIOT,

Petitioner,

vs.

DAVID C. TRAGER, DOING BUSINESS AS TOPIC TOYS, AND EOINA NUDELMAN, AN INDIVIDUAL,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To the Honorable the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Crest Specialty (Not Inc.), respectfully prays for a writ to the United States Court of Appeals for the Seventh Circuit to review the judgment entered by that court on the 16th day of October, 1950.

The transcript of record in the case, including the proceedings in the Court of Appeals, is furnished forthwith in accordance with Rule 38 of the Rules of this Court. The decision of the Court of Appeals appears in the record at page 188.* The opinion of the trial court appears in the record at page 111.**

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*Such decision also appears in the advance sheets of the United States Patent Quarterly, Vol. 87, p. 139.

**The findings of fact and conclusions of law of the trial court are reported at 89 F. S. 199.

SUMMARY AND SHORT STATEMENT.

1. Respondents, David C. Trager, doing business as Topic Toys, and Eoina Nudelman, filed suit against petitioner, Crest Specialty (Not Inc.), for infringement of claims 2 and 3 of the Nudelman patent, No. 2,455,266, issued November 30, 1948, on a Children's Amusement Device.

2. On January 19, 1950 (R. 111), the District Court filed its Findings of Fact and Conclusions of Law holding claims 2 and 3 in issue valid and infringed, and on January 26, 1950 entered judgment (R. 119) in favor of respondents.

3. By its decision (R. 188) dated October 16, 1950, the Court of Appeals for the Seventh Circuit in this case affirmed the judgment of the District Court holding claims 2 and 3 valid and infringed.

4. The patent in suit by its specification (R. 133) and drawings (R. 132) discloses, and claims 2* and 3 define, a children's amusement device comprising a figure formed to simulate a living creature attachable to a feeding bowl and having a passage therein through which food from the bowl may be fed back into the bowl. The feeding bowl *per se* is not a part of the patented structure. Fig. 5 of

*Typical claim 2 reads as follows: An amusement device comprising a figure formed to simulate a living creature, said figure comprising a body portion adapted to be placed adjacent the exterior of a feeding bowl, said body portion having a forwardly extending portion adapted to extend closely adjacent to and overlie a portion only of said bowl, said forwardly extending portion having a simulated mouth and a passage, said passage having walls extending solely downward from said mouth through said forwardly extending portion, whereby the contents of a spoon may be emptied into said simulated mouth and fall by gravity into said feeding bowl, said forwardly extending portion including means preventing lateral movement of said passage from over said bowl.

the drawings of the Nudelman patent is hereinafter reproduced on page 15 in comparison with Fig. 4 of a prior art patent to Smith, No. 2,207,417 (R. 170).

5. Nudelman by his claimed amusement device sought to provide an eating companion for a child and one which would encourage a child to eat by the process of mimicry.

6. When before the trial court, respondents acknowledged, and the trial court so found (R. 112) that

> "It was of the essence of Nudelman's concept that the device, employed for the purpose of providing instruction and encouragement for the child, simulate a living creature comprehensible to a child, and have body, head and mouth so that food could actually be fed to it, thereby creating the illusion of eating and thus stimulating, instructing, and encouraging the child to join the 'eating' table companion and to eat."

7. When before the trial court, respondents' counsel, after admitting (R. 66) that had a design patent been taken out on the claimed device instead of a mechanical patent, such design patent would have been invalid, argued that:

> "• • • it is very essential, in order to carry out Nudelman's concept, that you have a figure simulating a living creature, a living animal, so that you may put food into its jaws, which has the psychology of mimicry • • •."

8. As against the validity of the claims sued upon, petitioner cited and relied upon the prior art patent to Smith, No. 2,207,417 (R. 170).

9. The Smith patent by its specification (R. 171) and Fig. 4 of the drawing thereof (R. 170) discloses a bowl to which a hopper is detachably connected. Such hopper is provided with a passage discharging into the bowl for

the passage of food from the hopper into the bowl. A chart (Def. Exh. 2, R. 110) illustrating the device of claim 2 in suit in comparison with Fig. 4 of the Smith patent, is reproduced hereinafter, p. 15.

10. The object sought to be accomplished by Smith was to provide a cereal dish (R. 171)

> "which, due to the movement of the cereal into the liquid receiving portion, will interest a child eating cereal, in the operation of eating the same, to an extent that would not otherwise exist in children who do not particularly care to eat cereals of this character, thus aiding in feeding such children cereal by arousing their interest in the process of eating the same."

11. The Court of Appeals in this case in rejecting, as did the trial court, petitioner's contention that Smith disclosed a device which was not only capable of the accomplishments of the objects of the Nudelman device but also embodied a structure which was substantially the same as that claimed by Nudelman, said (R. 189-190):

> "In attempting to prove anticipation, defendants relied chiefly upon Smith No. 2,207,417, whose structure, the court found, is not only entirely unlike that of Nudelman but diametrically opposed in purpose and function, having in view an object entirely different from Nudelman's and providing a function entirely foreign to his. The other cited references are so far afield, as the court found and as we agree, that it is unnecessary to consider them. Upon all of the evidence submitted, the District Court found that anticipation had not been proved and that conception and production of a device such as that shown and described by Nudelman is beyond the skill of the mechanic and requires exercise of inventive genius.
>
> "A careful examination of the evidence is convincing that the trial court had before it adequate substantial evidence to justify its findings. Upon the issue as to validity the facts are such as to bring the

case within the scope of such decisions as *Paramount Corp.* v. *American Tri-Ergon Corp.*, 294 U. S. 464, *Wahl Co.* v. *Andis Clipper Co.*, 66 F. 2d 162, *Pyle Nat. Co.* v. *Lewin*, 92 F. 2d 628 (C. A. 7), *Peckat Mfg. Co.* v. *Jacobs*, 178 F. 2d 794 (C. A. 7)."

JURISDICTION.

1. The decision of the Court of Appeals was entered on October 16, 1950 (R. 188).

2. A petition for rehearing was denied by the Court of Appeals on November 9, 1950 (R. 193).

3. The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925 (28 U. S. C., Sec. 347) and Sec. 5(b) of Rule 38 of this Court.

4. Cases believed to sustain the jurisdiction are:

Rule 38, Section 5(b) reading:

> "Where a circuit court of appeals has rendered a decision in conflict with the decision of another circuit court of appeals on the same matter; or has decided an important question of local law in a way probably in conflict with applicable local decisions; or has decided an important question of federal law which has not been, but should be, settled by this court; or has decided a federal question in a way probably in conflict with applicable decisions of this court; or has so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a departure by a lower court, as to call for an exercise of this court's power of supervision."

Duplate Corp. & Pittsburgh Plate Glass Co. v. *Triplex Safety Glass Co. of North America*, 298 U. S. 448.

Sheldon v. *Metro-Goldwyn Pictures Corp.*, 309 U. S. 390.

Bacardi v. *Domenech Treasurer*, 311 U. S. 150.

QUESTION PRESENTED.

The decision of the Court of Appeals for the Seventh Circuit presents the following question:

Did the Court of Appeals in this case by its decision in holding claims 2 and 3 of the patent in suit valid depart from the test of invention as announced by the decisions of this Court?

REASONS RELIED UPON FOR ALLOWANCE OF THIS PETITION.

It is believed that the writ should be granted in this case for the following reasons:

1. In holding the patent in suit valid, the Court of Appeals has applied a test of invention which is contrary to the decisions of this Court as well as other Courts of Appeals.

2. The single question presented by this petition requires for its determination a pronouncement of what is the proper test of invention, thereby constituting the question one of great public importance for it not only affects the parties to this litigation, but it also affects every member of the public, particularly those dealing or concerned with patents.

3. Such question has long been a troublesome and perplexing question and one which arises without exception in every patent case in which the validity of a patent is put in issue.

WHEREFORE, it is respectfully submitted that this petition for writ of certiorari to the Court of Appeals for the Seventh Circuit should be granted.

CREST SPECIALTY (Not. Inc.),
Petitioner,

By CLARENCE E. THREEDY,
Its Attorney.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. .....

CREST SPECIALTY (NOT INC.) A LIMITED PARTNERSHIP CONSISTING OF BEN B. MANASTER, ROSE MANASTER, CAROL RUTH MANASTER, AND SOL ELIOT,

Petitioner,

vs.

DAVID C. TRAGER, DOING BUSINESS AS TOPIC TOYS, AND EOINA NUDELMAN, AN INDIVIDUAL,

Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To The Honorable The Chief Justice of the United States and The Associate Justices of the Supreme Court of the United States:

The decision of the Court of Appeals for the Seventh Circuit now sought to be reviewed was entered October 16, 1950 (R. 188).

Jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925 (28 U. S. C. Sec. 347) and Sec. 5(b) of Rule 38 of this Court.

STATEMENT OF THE CASE.

To avoid repetition, reference is hereby made to the statement on pages 2 to 4, *supra*, of the Petition for Writ of Certiorari.

SPECIFICATION.

The following are the alleged errors of the Court of Appeals for the Seventh Circuit which will be urged before this Court:

1. The Court of Appeals erred in sustaining the judgment of the trial court adjudging and decreeing claims 2 and 3 of the patent in suit valid.

ARGUMENT.

Your petitioner in presenting the petition for writ of certiorari has done so, fully realizing that many like petitions have been presented to this Court in the hope and expectation that some definite formula may be announced which will serve as a proper test of invention; or, in the alternative, that this Court will not hesitate to announce that the test of invention as laid down by this Court in its decision in *Cuno Engineering Corporation* v. *Automatic Devices Corporation*, 314 U. S. 84; 62 S. Ct. 37, 86 L. Ed. 58, 51 U. S. P. Q. 272, is no longer the test but

that the trier of each case shall formulate a test of invention according to the facts presented in such case.

Petitioner is motivated in the presentation of this petition for writ of certiorari, by the repeated rejection* by the Court of Appeals for the Seventh Circuit of the "flash of genius" test of invention as announced by this Court in the *Cuno* case, *supra.*

This case presents a situation where invention is said to have been spelled out upon the theory that the prior art device is "diametrically opposed in purpose and function, having in view an object entirely different from Nudelman's and providing a function entirely foreign to his" (R. 190). In other words, both the Court of Appeals and the trial court in this case have distinguished the claimed invention from the prior art in the light of the object accomplished, to-wit, that of teaching a child to eat by the process of mimicry. If the Court of Appeals had followed the test of invention as announced by this Court in the *Cuno* case, *supra,* it could have arrived at no other conclusion than that invention over the Smith patent (R. 170) is not spelled out by the claims in issue.

Is there to be a difference in measuring the standards of invention, among the several Courts of Appeals? In the language of the Court of Appeals for the Seventh Circuit in the case of *National Slug Rejectors, Inc.* v. *A. B. T. Manufacturing Corporation,* 164 F. 2d 812, is it the rule that

> "One court will reject what another accepts as patentable novelty, solely because of the difference in measuring standards"?

**Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.,* 132 F. 2d 812 (C. A. 7).
National Slug Rejectors, Inc. v. *A. B. T. Manufacturing Corp.,* 164 F. 2d 333 (C. A. 7).
Falkenberg v. *Bernard Edward Co.,* 175 F. 2d 427 (C. A. 7).
Peckat Mfg. Co. v. *Jacobs,* 178 F. 2d 794 (C. A. 7).

Is each of the ten Courts of Appeals to have its own test of invention, or should this Court lay down a test of invention to be followed by all Courts of Appeals? That is the important question which this petitioner presents to this Court for determination.

As the matter now stands among the several Courts of Appeals, if a manufacturer is sued for patent infringement in New York, he finds from a survey of the decisions of the Court of Appeals for the Second Circuit* that the test of invention is as announced by this Court in the *Cuno* case, *supra*, to-wit:

> "* * * the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling."

On the other hand, if such manufacturer is sued in Chicago, he is informed from a reading of the decisions of the Court of Appeals for the Seventh Circuit that the test of invention as announced by this Court in the *Cuno* case is flatly rejected.** This illustrates in a small but effective way the sharp conflict between the several Courts of Appeals as to what is a proper test of invention.

There is no conflict of decisions with respect to the patent in suit. Petitioner very frankly states that its hopes of obtaining the allowance of its petition are based upon the great importance of the single question presented, as this question affects every manufacturer who seeks to

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*_Weidhaas_ v. _Loew's Inc., et al._, 125 F. 2d 545 (C. A. 2). Other courts which have followed the *Cuno* case are as follows: _Anderson Co. et al._ v. _Lion Products Co., Inc. et al._, 127 F. 2d 454 (C. A. 1); _Pearson Sanding Mach. Co._ v. _Williams Furniture Co._, 132 F. 2d 55 (C. A. 4); _Trabon Engineering Corp._ v. _Dirkes et al._, 136 F. 2d 24 (C. A. 6); _Freeman et al._ v. _Altvater et al._, 138 F. 2d 854 (C. A. 8); _Standard Cap & Seal Corp._ v. _Coe_, 124 F. 2d 278 (App. D. C.); _In re Shortell_, 142 F. 2d 292 (C. C. P. A.).

**_Chicago Steel Foundry Co._ v. _Burnside Steel Foundry Co._, 132 F. 2d 812 (C. A. 7); _Falkenberg_ v. _Bernard Edward Co._, 175 F. 2d 427 (C. A. 7).

determine whether a patent upon which a charge of infringement is based, spells out invention. It is as much to his interest to know what the test of invention is, as it is to the patentee who asserts the charge of infringement.

Upon the foregoing premises, your petitioner prays that its petition be granted; that a writ of certiorari be issued and the case reviewed; and the judgment of the Court of Appeals with respect to the validity of the patent sued upon be reversed.

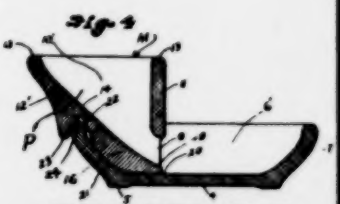
Respectfully submitted,

CREST SPECIALTY (NOT INC.),
Petitioner,

By CLARENCE E. THREEDY,
Its Attorney.

Chicago, Illinois,
December 6, 1950.

PATENT 2,456,266 IN SUIT



PRIOR ART PATENT 2,207,417
TO I.A. SMITH

CLAIM 2

An amusement device comprising

10 ..... a figure formed-to-simulate-a-living-creature, ... 10'

said figure comprising
16 ..... a body portion ..... 12', 23
adapted to be placed adjacent the exterior of
22 ..... a feeding bowl, ... 6'

said body portion having
27 ..... a forwardly extending portion 16
adapted to extend closely adjacent to and
overlie a portion only of said bowl,

said forwardly extending portion having
32 ..... a simulated mouth ..... M
24 ..... and a passage, ... P

said passage having
25 ..... walls extending solely downward 14
from said mouth through said forwardly
extending portion, whereby the contents of a
spoon may be emptied into said simulated mouth
and fall by gravity into said feeding bowl,

said forwardly extending portion including
20 ..... means preventing lateral movement 22
of said passage from over said bowl.